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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/570,483	03/01/2006	Kaoru Haruki	F-9034	9195
28107 7590 05/07/2009 JORDAN AND HAMBURG LLP 122 EAST 42ND STREET SUITE 4000 NEW YORK, NY 10168				
EXAMINER				
REICHEL, KARIN M				
ART UNIT		PAPER NUMBER		
3761				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/570,483

Applicant(s)

HARUKI ET AL.

Examiner

Karin M. Reichle

Art Unit

3761

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 11 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-8 and 10-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-8 and 10-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 March 2006 and 08 August 2008 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The response is considered the remarks and declaration filed 8-4-08, the drawing sheets and remarks filed 8-8-08, the substitute specification, marked up specification and remarks filed 1-12-09 and the claims filed 2-11-09.

Oath/Declaration

2. The oath or declaration filed 8-4-08 has been placed in the application.

Specification

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

For Example:

Drawings

3. The drawings were received on 8-8-08. These drawings are approved.

4. The drawings are objected to because Figures 8 and 9 are still not consistent with the description thereof on page 8, i.e. "when placed into a packaging bag", i.e. where is the placement in the bag shown? See discussion in paragraph 5 *infra*. In Figure 4, the sheet 21 rather than the entire diaper line should be clearly denoted. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid

abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Description

5. The substitute specification filed 1-12-09 has not been entered since a statement that such 1-12-09 specification contains no new matter did not accompany such submission, see MPEP 608.01(q). Therefore see the following paragraphs.

6. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are: the abstract and page 1, lines 10-24.

7. The abstract of the disclosure is objected to because the abstract is too long, i.e. more than 150 words in length. Correction is required. See MPEP § 608.01(b).

8. The disclosure is objected to because of the following informalities: 1) The Summary of the Invention section, i.e. a description of the claimed invention, and the invention of the claims should be commensurate, see MPEP 608.01(d), e.g. where is the invention of claims 2-8 described. 2) The specification should include the proper section headings as provided in 37 CFR 1.77(b). 3) Throughout the application, Applicants describe “identification information” as “including the size and the front or back side of the diaper main body, and the like” (emphasis added). It is unclear what such information as so described includes, e.g. information of size and information of side and information something like that? Information which imparts all three at once? What information is considered “and the like”? (Note page 13, first full paragraph, e.g. information imparts both size and side but not also something “like that”, and the paragraph bridging pages 20-21 and Figure 7, e.g. information which imparts size and separate information which imparts side but not also something “like that” too or separately). Note the claims as now amended also. A clear, complete description of such terminology should be set forth. See also discussion *infra*. 4) The description of Figures 8 and 9 on page 8 is inconsistent with the Figures and the description on, e.g., page 22, lines 13-14. A consistent description should be set forth throughout the application.

Appropriate correction is required.

Claim Objections

9. Claims 6 and 11-13 are objected to because of the following informalities: Claim 6, line 3 and claim 12, lines 3-5 include numerous grammatical errors. Claims 11 and 13 are considered claims dependent from claim 1 and 7, respectively. However, the preamble of claims 11 and 13 are inconsistent with those of claims 1 and 7, respectively. Appropriate correction is required.

Claim Rejections - 35 USC § 112

10. Claims 1, 3-8 and 10-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regard to claim 1, lines 33-34, claim 7, lines 30-31 and claim 11, a positive structural antecedent basis for “said at least...indicia indicating said size...body” should be set forth.

Claim Language Interpretation

11. Claims 1, 3-8 and 10-12, see, e.g., lines 17-22 and 26-33 of claim 1, claims 3-5, claims 8 and 10, are product by process claims, see MPEP 2113, i.e. [E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Also, lines 26

et seq do not set forth when such folding over takes place. Therefore, the end product of claim 1 is considered to be the structure set forth on lines 1-25 (It is noted with regard to the waist and leg-hole elastics, it is not clear what end structure would result from attaching in an expanded state, e.g. could be gathered or not) having a fold as set forth on lines 40 and 29-34, first and second body portions overlaying each other at some time having the function, capability or property set forth on lines 34-38. The end product of claims 3-5 is considered to be a display part positioned on both the front and back portions, at least the front portion and at least the back portion, respectively. It is noted that the longitudinal extents of the front, rear and crotch portions relative to the overall extent of the main body have not been set forth. The end product of claim 6, due to the lack of clarity discussed supra in paragraph 9 also, is considered to require the leg hole elastic members not extend into some portion of the display part which portion of such part has the information there on. The end product of claim 7 is the same as claim 1 discussed supra but also includes folds, i.e. more than one, but one of such folds does not have to be across the crotch portion and flat portions overlying other flat portions so as to have define a rectangular or square outline as set forth on lines 24-25 when folded at some time. The end product of claims 8 and 10, is considered to require printing of the size, i.e. the size in ink, on the display part body (It is noted that the dictionary defines "printed" as "lettering or other impressions produced in ink from type by a printing press or other means"). Due to the lack of clarity discussed supra in paragraph 9, claims 11 and 13 are considered to require a stack of the diapers of claims 1 and 7 with the function, capability or property set forth on lines 3-5. It should be noted that "a side" does not require a particular side or the same side with regard to each of the diapers. Due to the lack of clarity discussed supra in paragraph 9, claim 12 is considered to require each leg hole elastic

member include two discontinuous sections with an area therebetween in which at least part of the display part is disposed but at least part of the information is not present.

Claim Rejections - 35 USC § 103

12. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

13. Claims 1, 3-8 and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over SCA 'PCT '845 in view of Cammorata et al '162 and MacDonald '665.

Claim 1: See Claim Language Interpretation section supra, hereinafter also referred to as CLI, and '845 at the Figures, esp. 1 and 4, the abstract, page 1, lines 3-7, page 2, lines 25-32, page 3, lines 1-3, 8-9 and 23 et seq, page 4, lines 1-3 and 25 et seq, page 5, lines 1-2, and 10 et seq, page 6, lines 4-12 and 18-25 and its claims, i.e. '845 teaches a folded, see page 6, lines 20-25, disposable diaper, see Figure 1, comprising a diaper main body 1 having a front abdomen portion 5, a back portion 6, and a crotch portion 7 interconnecting the front abdomen portion and the back portion, the crotch portion 7 having opposing side edges formed as leg hole sections which are between the abdomen portion and the back portion and define leg hole, see Figure 1, the crotch portion extending widthwise between the leg hole sections, see Figure 1, the front abdomen portion having opposing abdomen side edges and the back portion having opposing back side edges, see Figure 1, the abdomen side edges being respectively joined to corresponding ones of the back side edges to define a waist opening, see the paragraph bridging pages 4-5 and note the claim does not require permanent joining nor a pant diaper, the diaper main body being provided with an absorbent main body 4 at the crotch portion, a leg-hole elastic member, i.e. at

least one member of each 12, attached along each of the leg hole sections, see CLI supra, the diaper main body having a display part, e.g. 10, on which is provided information including a size of the diaper main body, 11, see Figures. Claim 1 also requires 1) waist elastic members attached in an expanded state, see CLI, and 2) the diaper main body being folded over at a fold so as to define a first diaper body portion on one side of the fold and a second diaper body portion on another side of the fold, the first and second diaper body portions being overlaid flat on each other, and the fold defining a fold edge face between the first and second diaper body portions, the fold edge face being exposed and facing outward in a direction substantially parallel to first and second planes of the first and second diaper body portions, at least a portion of the display part being disposed on the fold edge face, the at least a portion of the display part including indicia indicating the size of the diaper main body such that the size is viewable when two or more like folded diaper main bodies are stacked on one another with all the first and second planes of the like folded diaper main bodies parallel to each other, and the fold extending widthwise across the crotch portion, see CLI supra. While '845 does not teach waist elastic members and does not explicitly teach a fold as set forth on lines 40 and 29-32 nor first and second body portion overlaying each other at some time having the function, capability or property set forth on lines 34-38, it does teach an article which can have the design of a diaper pant, see, e.g., page 5, lines 10-14 of '845, and at least a portion of the display part 10 being disposed on a fold edge face in the folded package condition of the article, the at least a portion of the display part including indicia 11 indicating the size of the diaper main body such that the size is viewable when articles have been taken out of their packages and placed on a shelf or the like, see, e.g., page 6, lines 8-12 and 20-25. However, see also '162, at Figures 1-9C and,

e.g., paragraphs 1, 6, 9, 14, 21, 30, 36, 48, 56, 68- 73, 76, and '665 at the Figures and, e.g., col. 2, line 56-col. 3, line 62, col. 4, lines 25-39, col. 7, lines 30-34 and col. 2, lines 25-30, i.e. an absorbent article of diaper pants design includes elastic waist elements as well as is folded in half (i.e. the diaper main body being folded over at a fold so as to define a first diaper body portion on one side of the fold and a second diaper body portion on another side of the fold, the first and second diaper body portions being overlaid flat on each other, and the fold defining a fold edge face between the first and second diaper body portions, the fold edge face being exposed and facing outward in a direction substantially parallel to first and second planes of the first and second diaper body portions, and the fold extending widthwise across the crotch portion fold) and attached at its side edges to form pants (i.e. the diaper main body also being folded along such side edges at folds to have flat portions of the diaper main body overlaid on other flat portions of the diaper main body) and/or folding such diaper pants design for packaged/stored/stacked condition (i.e. folded as discussed supra so as to have one of a rectangular and a square outline when viewed from a direction normal to the flat portions). Therefore to employ a diaper pants design such as, for example, taught by '162 and '665 as the absorbent article of '845 would be obvious to one of ordinary skill in the art in view of the recognition that such design is known to be used in combination with wetness indicators and/or graphics and the desire of '845 to be an absorbent article with wetness indicators and/or graphics of a diaper pants design. In so doing it is the Examiner's first position that the prior art contemplates the diaper of 1) and 2) supra, see CLI, i.e. the structure set forth on lines 1-25 (It is again noted with regard to the waist and leg-hole elastics, it is not clear what end structure would result from attaching in an expanded state, e.g. could be gathered or not) having a fold as set forth on lines 40 and 29-34,

first and second body portion overlaying each other at some time as well as the function, capability or property set forth on lines 34-38. In any case, i.e. the Examiner's second position, at the very least, the prior art contemplates the same structure set forth on lines 1-25 having a fold as set forth on lines 40 and 29-34, and first and second body portions overlaying each other at some time. Therefore, there is sufficient factual evidence that such same structure would necessarily and inevitably include the same capability, structure or function claimed, i.e. of lines 34-38. Finally, i.e. the Examiner's third position, if not already, it would be obvious to store or shelf absorbent articles/diaper pants as contemplated by the prior art stacked on one another as claimed, such as, for example taught by '665, e.g. Figure 4, in view of the recognition that such is storage/space efficient and the desire of such, especially in space conscious/economic/efficient situations such as nursing homes or the like. In so doing, the prior art would necessarily and inevitably include the capability, structure or function of lines 34-38, see again CLI supra as well as page 6, lines 8-12 and 20-25 of '845.

Claims 3-5: The display part is extended and formed over the front abdomen portion, the back portion or both, see CLI, the discussion of claim 1 and cited portions of '845 and '162, e.g. strip 10 which has width and length at folds and there are folds in both such portions, e.g., at side edges, at the crotch.

Claim 6: The leg-hole elastic members are disposed so as to not extend into an area in the display part where the information is provided, i.e. see CLI and, e.g., '845, e.g. elastic elements 12 in Figures 1, 3-4 and the information 11 on 10 with regard thereto.

Claim 10: The size is printed on the display part of the diaper main body by means of an ink-jet system, see CLI and, e.g., page 3, line 8 of '845, i.e. the size is printed.

Claim 11: An assemblage of diapers folded as claimed in claim 1 are stacked on one another in a stack with all the first and second planes of the diapers parallel to each other, and the indicia indicating the size of the diaper main bodies of the diapers being viewable from a side of the stack, see CLI supra and the discussion of claim 1 supra, i.e. a stack of the diapers as claimed in claim 1 with the function, capability or property set forth as set forth on lines 3-5 is contemplated, necessarily and inevitably included or obviously contemplated by the prior art.

Claim 12: The leg-hole elastic member of each of the leg hole sections includes two discontinuous sections, i.e. two section/lines of 12 of each leg hole as seen in Figures 1 and 3-42, with a break area in which at least part of the display part 10 is disposed but at least part of the information 11 is not present, as best understood, see CLI supra and the discussion of claim 6, i.e. the prior art contemplates the display area 10 but not the information 11 thereon spanning the area between the elements of 12 on each leg hole.

Claim 7: See discussion of claim 1. Additionally claim 7 claims the diaper main body being folded at folds to have flat portions of the diaper main body overlaid on other flat portions of the diaper main body so as to have one of a rectangular and a square outline when viewed from a direction normal to the flat portions; and the diaper main body being folded over at a fold of the folds so as to define a fold edge face between at least two of said flat portions, see CLI supra and, e.g., Figure 4 of '665 again.

Claims 8 and 13: See discussion of claims 10 and 11 supra.

Response to Arguments

14. Applicant's remarks have been carefully considered but are either deemed moot in that the issue discussed has not been reraised or deemed not persuasive in light of the discussion supra. Applicant's attention is also invited to MPEP 2106.01, fourth full paragraph, with regard to patentable weight accorded to printed matter.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any new grounds of rejection were necessitated by the amendments to claims 1, and 3-8, the cancellation of claim 9 and the addition of claims 10-13.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karin M. Reichle whose telephone number is (571) 272-4936. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Karin M. Reichle/
Primary Examiner, Art Unit 3761

May 6, 2009